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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,009	01/14/2004	James R. Matera JR.	1021-3 CON	3306
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Joseph W. Schmidt Carter, DeLuca, Farrell, & Schmidt, LLP Suite 225 445 Broadhollow Road Melville, NY 11747				
EXAMINER				
ERIZO, DARWIN P				
ART UNIT		PAPER NUMBER		
3773				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/757,009

**Applicant(s)**

MATERA, JAMES R.

**Examiner**

Darwin P. Erezzo

**Art Unit**

3773

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12, 14-16 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 14-16 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,197,034 to Gvozdic et al.

Gvozdic discloses a surgical dispensing instrument comprising an ink cartridge **2** defining an enclosed internal chamber (see Fig. 2); a sterile tattoo ink **6** disposed within the enclosed internal chamber of the ink cartridge; and a surgical needle **10** removably mounted to said ink cartridge (Fig. 3); wherein the ink cartridge is substantially flexible (col. 8, line 10); wherein the instrument further comprises a removable enclosure or endcap for covering the port of the ink cartridge to prevent the ink from drying (col. 8, lines 52-55); and wherein the needle is fully capable of being removed from the ink cartridge via any type of cutting means.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 12, 14-16, 24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,197,034 to Gvozdic et al. in view of US 2,679,246 to Cohen.

(claims 12 and 26) Gvozdic discloses a surgical dispensing instrument comprising an ink cartridge **2** defining an enclosed internal chamber (see Fig. 2); a sterile tattoo ink **6** disposed within the enclosed internal chamber of the ink cartridge; and a surgical needle **10** removably mounted to said ink cartridge (Fig. 3); wherein the ink cartridge is substantially flexible (col. 8, line 10).

Gvozdic is silent with regards to the surgical needle having an internal thread for engaging the cartridge (means for releasably coupling the needle from the cartridge); wherein the cartridge has a port in communication with the needle.

However, the use of a separate needle from a cartridge holding a fluid is well known in the art. For example, Cohen discloses an instrument for dispensing fluids, the instrument comprising a needle housing **12** having an internal thread for mating with a cartridge housing **10** having a port insertable into a lumen of the needle housing (see Figs. 1-2).

Therefore, it would have been a mere obvious design choice to one of ordinary skill in the art at the time the invention was made to modify the invention of Gvozdic to have a separate needle since such an arrangement is well known in the art, as disclosed by Cohen. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). It has also been held that the use of a known technique (separable needle) to improve similar devices (fluid injection) in the same way would provide predictable results and would be obvious to one of ordinary skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1396 (2007).

(claims 14-16 and 24) The device of Gvozdic, as modified by Cohen, discloses a removable needle. It is also noted that Cohen discloses an end cap enclosure **13** that is capable of securing the port of the ink cartridge when needle portion **20** is absent in the needle housing **12**; wherein the end cap enclosure is releasably mounted to said cartridge via the needle housing **12**. Thus, it would be obvious to provide the end cap enclosure of Cohen to the modified device of Gvozdic in order to provide a cover for the needle when the device is not in use.

(claims 27 and 28) The modified device of Gvozdic has a member adjacent the port; wherein the member can be a needle **20** or an endcap **13**.

With regard to the use of the term "adjacent" in the limitation "...a member mounted to said ink cartridge adjacent said port...", it is noted that "adjacent" is a relative term and does not convey any specific dimension or distance between the

member and the port. As such, the indirect connection between the endcap **13** to the port via the needle housing **12** is viewed as being adjacent the port. The claim also does not specify that the endcap is directly mounted to the cartridge. Since the claim uses the transitional phrase "comprising", it allows for other elements to be present in the invention and between structures.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 12, 14-16, 24 and 26-28 have been considered but are moot in view of the new ground(s) of rejection.
7. Applicant's arguments with respect to claims 23 and 25 have been fully considered but they are not persuasive.

The applicant argued that Gvozdic fails to disclose "an end cap for covering the port of the ink cartridge sterile and being releasably mounted to said ink cartridge" and "said ink cartridge is substantially flexible to permit the operator to manually deform said ink cartridge by direct engagement of said ink cartridge with a hand of the operator". However, these arguments are not persuasive.

With regards to the end cap being releasably mounted to the cartridge, it is noted that the claim does not specifically recite what type of connection is provided between the end cap and the cartridge, whether it is a direct connection or an indirect connection. As such, the device of Gvozdic anticipates the invention, as currently recited in the claim, since the endcap is mounted indirectly to the ink cartridge via the needle.

With regards to the ink cartridge being flexible to permit direct engagement of said cartridge by a hand of a user, it is noted that this is a mere functional limitation. The structure implied by this limitation is that the ink cartridge is flexible. As stated above, the ink cartridge of Gvozdic is flexible. It is also fully capable of being manipulated by a user's hand without the use of handle 14. Handle 14 uses a plunger to press against the side of the cartridge. This force can easily be simulated by pinching the cartridge with a user's fingers. It is noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erezó whose telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erezó/  
Primary Examiner, Art Unit 3773